

REMARKS

Summary

Claims 1, 2, 4-9 and 11-14 were pending. Claims 1, 2, 4-9, and 11-13 were rejected; Claim 14 has been allowed. Claims 12 and 15-17 have been cancelled. Claims 1, 9 and 11 have been amended. No new matter has been added. The Applicant respectfully traverses the rejections.

After carefully reviewing the prosecution history, the Applicant cannot find any new rejection of Claim 8 in Office actions subsequent to the Office action of November 11, 2007, where Claims 8 and 9 were objected to on the basis that they were dependent on a rejected base claim. The reference used in making the rejection of the base claim, Khutoryansky, remains the same. The Applicant has now amended Claim 1 to incorporate the subject matter of Claim 8, which has been cancelled. The subject matter previously added to Claim 1, and which was rejected under 35 U.S.C. 112, first paragraph, has been removed, although the traverse of such a rejection is respectfully maintained, and addressed in relation to Claim 11.

As such, the Applicant respectfully submits that amended Claim 1 is not anticipated or obvious and is allowable, as are the claims dependent thereon.

Claim Rejections

35 U.S.C. § 112, first paragraph

Claims 1, 2, 4-9 and 11-13 were rejected on the basis of 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Applicant respectfully traverses this rejection. The rejection of Claim 1, and the claims dependent thereon is moot in view of the amendment to Claim 1 and the remarks above.

The Applicant respectfully submits that the application as filed (including the original claims) gives full support for the subject matter claimed in Claim 11.

The purpose of the written description requirement is to ensure that the applicants convey with reasonable clarity to those skilled in the art that they were in possession of the invention as of the filing date of the application. For the purposes of

the written description requirement, the invention is "whatever is now claimed." *Vas-cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

At paragraph [003] (page 4; the paragraph numbering seems to have been restarted at page 4), for example, the specification recites that "regardless of the x-ray source angle of rotation with respect to rotation about the horizontal axis, the lower edge of the x-ray source is always located below the lower edge of the support arm...." Further, original Claim 1 expressed this as "independently of an x-ray source angle of rotation about the horizontal axis." Each of the separately, and certainly together, indicate that the condition is true for any rotation angle about the horizontal axis.

The Examiner refers to Figs 1, 2 and paragraph 8 of the specification as showing specific examples of 0 and 90 degrees rotation to support the rejection. However, this is only an example of a position of the X-ray apparatus, and to use an example to limit the claimed invention would be to read the limitations of the specific example, as illustrated in what must necessarily be a limited number of drawings, into the claims. Elsewhere in the specification the independence with respect to the rotation angle is clearly set forth.

In responding to Applicant arguments in a previous Office action (November 9, 2007, page 7), the Examiner noted that the "features upon which the Applicant relies (i.e., a rotation of plus or minus 180 degrees measured from a reference position and the total angle of rotation of envelope limitation being 360 degrees) are not recited in the rejected claim(s)." "Although the claims may be interpreted in light of the specification, limitations from the specification are not read into the claims." That is, the reason that the claim was rejected, was that limitations understood by the Examiner to present in, or equivalent to, the subject matter disclosed in the specification were not recited in the amended Claim 1.

The Applicant has amended Claim 1 so as to return to the original wording of the claim, which is self-supporting. The Applicant respectfully submits that this obviates the rejection on the basis of 35 U.S.C. § 112, first paragraph. Claims 2, 4, 5 and 9, being claims dependent on an allowable claim are allowable, without more.

35 U.S.C. § 103(a)

Claims 1, 2, 4, 5, 7 and 11-13 were rejected under 35 U.S.C. § 103(a) as being anticipated by Khutoryansky et al. (US 5,636,259; "Khutoryansky") in view of Mekker et al. (US 4,727,564; "Mekker"). The Applicants respectfully traverse the rejections on the basis that a *prima facie* case of obviousness has not been made out. Claims 1, 2, 4, 5, and 9 are allowable as amended, as argued above.

Amended Claim 11 recites, *inter alia*, the horizontal axis of rotation of the x-ray source is positioned on the support arm such that a portion of the envelope of the x-ray source remains below the lower edge of the support arm and the lower edge of the mounting device when the envelope is rotated, independently of the angle of rotation.

This added phrase was found in Claim 11 as originally submitted.

This aspect of Claim 11 was addressed in the advisory action of June 4, 2007. The Examiner agreed that "if a condition is true and sometimes is not true, with respect to an angle, it is not independent of the angle of rotation." The action goes on to assert that "Khutoryansky et al. does show that the condition is always true, with respect to an angle of rotation, wherein the angle of rotation is from 0 to 90 degrees (figs 8-11, #112)". In the Office action of August 15, 2008, the Examiner accepts that Khutoryansky fails to unambiguously disclose rotation over an angle greater than 180 degrees, and now depends on Mekker to teach rotation over an angle greater than 180 degrees. (Id., item 3, page 3, bottom).

The Applicant respectfully submits that while Khutoryansky does not teach that the angle of rotation is greater than 180 degrees, neither does it teach that it is limited to a maximum of 180 degrees. That is, the teaching is ambiguous in this respect. At rotation angles greater than 180 degrees, if such angles were possible with the apparatus of Khutoryansky, the limitation of Claim 11 may not be met. The Applicant respectfully submits that it is not correct to assert a limitation angle of rotation of Khutoryansky to a range of angles, where such a range of angles is not a limitation of the Claim 11 or taught in the reference. That is, this aspect of the reference is not read on by the claim.

It is well settled that an anticipation rejection cannot be predicated on an ambiguous reference (*In re Turlay*, 304 F.2d 893, 899 134 USPQ 355, 360(CCPA 1962)).

The Office action depends on Mekker to remedy this deficiency. Khutoryansky is posited as the "base system" and the disclosure of Mekker is used to supply the missing element. This is asserted to be an "improvement" on the "base system". The motivation for this improvement is said to be found in the abstract of Mekker as being "greater movement and flexibility". The abstract states that "[t]he masts move independently of one another but can also be linked together for movement in unison". There is no implication that this "greater movement and flexibility" applies to the rotation of the x-ray assembly 26, and any such motivation must be seen to arise from the Applicant's own claims.

The Office action cites fig. 4, reference numeral 50, as demonstrating that Mekker teaches a 360 degree rotation range. The apparatus 47 for mounting the x-ray assembly 26 to the mast 24 is manually operated, as may be seen from the dogs 104 used to secure the joint in the desired position. Khutoryansky teaches that the x-ray apparatus (Khutoryansky, fig 3, reference numeral 112, col. 12, line 60-bridging col.13, line 47) is rotated about the horizontal axis by a motor driven device, as part of the overall positioning and control function of the system. Substituting a manually rotatable joint into an automatically-controlled system would not be seen as an "improvement" on the system described by Khutoryansky. More particularly, as the "base system" is intended to operate under automatic or computer control for positioning, the resultant combined system would be inoperative for its intended purpose. Such an inoperative combination cannot be used to make out a *prima facie* case of obviousness. *In re Spornoble*, 405 F.2d 578, 587 (CCPA 1969).

Claims 12 and 13 are claims dependent on allowable Claim 11 and are allowable, without more.

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Khutoryansky and Mekker as applied to Claim 1, and further in view of Horbaschek (US 2002/0118793; "Horbaschek"). The additional reference is not asserted to overcome the deficiencies in the rejection of Claim 1, as amended, and Claim 6 is allowable, without more.

Conclusion

Claims 1, 2, 4-6 and 11-14 are pending.

For at least the reasons given above, the Applicant respectfully submits that the pending claims are allowable and looks forward to the early issuance of a Notice of Allowance.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,



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